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OFFICE OF PETITIONS

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Andrea M. Douglas, et al.

Examiner: R. Deberry

Serial No: 09/051,939

Art Unit: 1647

Filed: October 16, 1998

Docket: 11375

For: CYTOKINES AND THEIR USE IN
TREATMENT AND/OR PROPHYLAXIS
OF BREAST CANCER

Dated: May 23, 2001

Assistant Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

PETITION UNDER §§1.181 AND 1.53(e)

Sir:

In accordance with the provisions of 37 C.F.R. §1.181 and 1.53(e), applicants submit the following petition for conversion of an application inadvertently filed under 37 C.F.R. §1.53(d) to an application filed under 37 C.F.R. §1.53(b).

On March 5, 2001 applicants filed a request transmittal for a continued prosecution application under 37 C.F.R. §1.53(d) together with the filing fee \$1,212.00 and a petition for three month extension of time, together with a check in the amount of \$890.00.

On March 22, 2001, the United States Patent and Trademark Office issued a "Notice of Improper Request for Continued Examination (RCE)". The undersigned official of the PTO, Ms. Gloria Trammell was contacted in an attempt to clarify the response date for the communication. Ms. Trammell indicated on three separate occasions (April 9, May 11 and May 18, 2001) that a response was due to this "miscellaneous office action" two months from the mailing date thereof (i.e. May 22, 2001).

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Applicants were contacted by Examiner Deberry on May 16 and informed that the Examiner intended to abandon the application because the application was filed under the incorrect provision of 37 C.F.R. §1.53. Applicants sought further clarification of the time period for response to a Notice of Improper Request for RCE conferring with Mr. Robert Barr of the Commissioner's office on May 21, 2001. Mr. Barr opined that the period for response was from the date of the last Office Action and a two month shortened and statutory response period was not available.

Applicants submit that the filing of a request for CPA was an inadvertent filing error which should not result in abandonment of the application. Specifically, under 37 C.F.R. §1.53(e) "[i]f an application deposited under paragraph (b), (c) or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified... and a given time period within which to correct the filing error".

In the present circumstance, applicants have no time left in the statutory response period, nor were applicants given any time to correct the filing error. Applicants respectfully submit that a reasonable time period should be given for the correction of the filing error as required by 37 C.F.R. §1.53(e).

Nevertheless, Applicants provide herewith a request for a utility patent application (continuation application under 37 C.F.R. §1.53(b)) together with a specification and preliminary amendment for substitution for applicants' request for CPA filed on March 5, 2001. Applicants further submit that the PTO has, on March 8, 2001, charged applicants' deposit account for the filing fees and debited the requisite extension fees. Accordingly, no further filing fees are required.

Please charge the requisite fee of \$130.00 for this filing to Deposit Account No. 19-1013/SSMP. Any additional charges required in connection with this submission may also be charged to Deposit Account No. 19-1013/SSMP. A duplicate of this sheet is enclosed.

Finally, applicants have concurrently filed herewith a Petition to Make Special pursuant to 37 C.F.R. §1.102(d), in view of the imminent prospect of the issuance of a notice of abandonment involving the above-identified application.

Respectfully submitted,



Frank S. DiGiglio
Registration No. 31,346

Scully, Scott, Murphy & Presser
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Attention: Office of Petitions

Box DAC

Assistant Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

(Petition to expedite)

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. §1.102(d)

Sir:

Applicant hereby petitions to make special the accompanying Petition Under 37 C.F.R. §§1.181 and 1.53(e).

The above-identified application was inadvertently filed under the incorrect provision of 37 C.F.R. §1.53 on March 5, 2001. The Examiner in charge of the application has indicated an intention to issue a notice of abandonment of the application based on applicants' alleged failure to file a continuing application under the correct provision of 37 C.F.R. §1.53 (i.e. 1.53(b)).

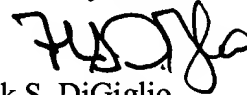
Pursuant to 37 C.F.R. §1.53(e), if an application deposited under Paragraph (b), (c) or (d) does not meet the requirement of such paragraph to be entitled a filing date, applicants will be notified and given a time period within which to correct the filing error. No time period within which to correct the filing was offered to applicants in the present circumstance.

Applicants have concurrently filed a request for a continuing application under 37 C.F.R. §1.53(b) to substitute such filing for the original filing under 37 C.F.R. §1.53(b).

Accordingly, applicants respectfully request that the petitions branch expedite the processing of the enclosed Petition under 37 C.F.R. §1.181 and 1.53(e) to preserve applicants' filing date.

Please charge the requisite fee of \$130.00 for this filing to Deposit Account No. 19-1013/SSMP. Any additional charges required in connection with this submission may also be charged to Deposit Account No. 19-1013/SSMP. A duplicate of this sheet is enclosed.

Respectfully submitted,



Frank S. DiGiglio
Registration No.: 31,346

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